

Appl. No. : 09/694,667  
Filed : October 23, 2000

#### REMARKS

Claims 101 and 106 have been amended to correct the typographical error identified by the Examiner. Withdrawal of the objection is respectfully requested.

Claims 96 to 106 are pending in the present application with claims 96 and 102 as independent claims. The Examiner has rejected each of the independent claims under 35 U.S.C. § 102(b) as being anticipated by Nishioka.

Claim 96 is being amended to further distinguish over the reference to Nishioka and to recite explicitly the structure previously inherent within claim 96. As such, Claim 96 as amended recites that each of the magnetic members has an exposed rearwardly directed end face that is adapted to cooperate with and secure the auxiliary lenses.

Nishioka discloses spectacles in which the magnets 7 have an exposed face that is directed forwardly so as to be visible from the front of the wearer. The sunglasses are secured to the magnet 7 by cooperation of this forwardly directed exposed surface. There is no disclosure in Nishioka of the magnets 7 having an exposed rearwardly directed surface as now recited in claim 1. Indeed, such a structure would clearly have no utility within the context of Nishioka as the intent is to secure the sunglasses by contact with the forwardly directed exposed face of the magnets.

By contrast, the present application discloses at Figures 14 through 17, for example, the provision of a magnet in which the rearwardly directed face is exposed so as to cooperate with the arm associated with the sunglasses. In this manner, it is not only possible to hide the magnet, as shown by the provision of the lateral arm extending from the uniblock in Figure 14, but also allow the arm on the sunglasses to inhibit relative forward movement between the sunglasses and the main frame.

The Nishioka reference is entirely silent as to a construction having the features recited in claim 96 and accordingly, Nishioka cannot be considered to be an anticipatory reference under 35 U.S.C. § 102(b).

Claim 102 has been amended to explicitly recite that the end face of the magnetic members is rearwardly directed. Moreover, claim 102 recites that the auxiliary frame includes a pair of arms that extend rearwardly so as to overly the rearwardly directed surfaces of the main frame. Such a structure cannot be found in Nishioka, where there is no rearwardly directed end face disclosed and where the auxiliary frame does not have arms that overly the rearwardly

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directed surfaces of the main frame. As such, it is believed that claim 102 is not anticipated by Nishioka. In view of the fact that each of the independent claims 96 and 102 distinguish over the Nishioka reference, it is believed that claims 97 through 100 and claims 103 and 104 likewise clearly are not anticipated by the Nishioka reference.

The Examiner has rejected claims 101 and 106 under 35 USC 103(a) in view of a combination of Nishioka and Nerney. The reference to Nerney simply shows a spectacle in which the frame is split at the hinge point of the frame. There is, however, nothing in Nerney that suggests the use of the frame connections as a location for a magnetic insert as required by claim 101 and 106. The combination of Nerney with Nishioka is neither suggested nor is there any motivation for making such a combination. In particular, it is noted that Nishioka appears to show a frame in which only a portion of the lens is circumscribed by the frame. There is therefore no motivation to utilize the structure shown in Nerney with the frame as shown in Nishioka. Simply put, Nishioka does not require the facility offered by Nerney. Conversely, Nerney does not contemplate the use of the magnetic insert to secure the sunglasses. Accordingly, the combination suggested by the Examiner is not appropriate.

Moreover, even if such a combination were made, there is no reason to suggest that it would result in the configuration recited in claims 96 and 102. As noted above, Nishioka does not teach the provision of the rearwardly directed magnetic faces and there is nothing in Nerney to suggest that the magnets would be placed in the orientation recited in the independent claims. Accordingly, the combination suggested by the Examiner would not result in the invention claimed. As such, it is believed that claims 101 and 106 clearly and patentably distinguish over the combination made by the Examiner.

The Examiner has also rejected claim 105 in view of a combination in Nishioka and Chao. The Examiner acknowledges that Nishioka does not disclose the arm engageable with the rearwardly directed surface and relies on Chao for that feature. However, claim 105 requires the magnetic member to have an end face parallel to the rearwardly directed surfaces and for the arms and the magnetic members to cooperate to secure the auxiliary frame to the primary frame. Chao does not disclose an arrangement in which the end face of the magnetic member is parallel to the rearwardly directed face of the arm. As can be seen in Figure 7, the end face of the magnetic member as disclosed is vertically oriented and not parallel to a rear surface. As such,

Appl. No. : 09/694,667  
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the combination made by the Examiner does not teach the invention specifically claimed in claim 105 and as such is believed to be in condition for allowance.

It is believed therefore that the claims as amended and presented herewith are in condition for allowance and action to that end is respectfully requested.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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